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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,538	12/28/2004	Yoshiko Hino	47233-0049-00-US (220489)	2594
55694 7590 03/23/2009 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
PADEN, CAROLYN A				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/519,538

**Applicant(s)**

HINO ET AL.

**Examiner**

Carolyn A. Paden

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 2-6-09

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 6, 2009 has been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weyersbach (5,389,394) as further evidenced by Minifie and in view of Rusoff (2,957,769) and Terauchi (4,758,444 or 4,871,562) .

Weyersbach discloses producing cocoa extract. In example 1, cocoa nibs are poured into a column and extracted with water at 73C for 2.5 hours to form a cocoa extract. The range of extraction temperatures is disclosed to be from 40-100C. The claims appear to differ from Weyersbach in the recitation of the use of a two phase centrifuge to

perform the extraction. But applicant uses strainer as an alternative to centrifugation at page 8, lines 11-15. The extraction method of Weyersbach is seen to be an obvious alternative to centrifugation. Further Rusoff teaches the use of a centrifuge as an alternative means of filtration at column 4, lines 66-68. It would have been obvious to use centrifugation in the Weyersbach extraction method as an alternative way of separating solid from liquid in a cocoa making process. It is appreciated that the extraction temperature is not mentioned as being above the melting point of cocoa fat. But it is known in the art that the extraction temperature of 73C is above the melting point of cocoa butter and Minifie is relied upon for support of this assertion. With the evidence of Minifie before him, it would have been obvious to one of ordinary skill in the art to utilize the process of Weyersbach to prepare the cacao extract of the claims.

Applicant argues that Weyersbach does not use a centrifuge but Rusoff teaches that centrifuges are known in the art as an alternative means of filtration. Further Terauchi teaches the heated centrifuges were known in the art at the time of applicants' invention. It would have been obvious to substitute the heated centrifuge of Terauchi as an obvious alternative filtration system in Weyersbach.

Claims 1, 5, 8 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terauchi (4,758,444 or 4,871,562) alone or if necessary as further evidenced by Minifie.

Terauchi discloses the preparation of cacao beans. In example 2 cacao beans are shelled and cracked to produce cacao nibs. Then sodium carbonate and water are added, mixed and stirred at 90C for one hour. Then the cacao mass was stirred in water maintained at 120C and converted into a colloidal form. The mixture was then introduced into a centrifugal separator to extract the water soluble portion of the cacao. The water soluble portion was concentrated at 90C and then spray dried at 100C. Then the cacao was formulated into a beverage in Test Example 2 for taste evaluation. In test example 3, powdered milk and cocoa butter were included. The claims appear to differ from Terauchi in the recitation of the temperature of extraction but cacao fat is known to have a melting point that is lower than 90C and Minifie is relied upon for support of this assertion. With the evidence of Minifie before him, it would have been obvious to one of ordinary skill in the art to utilize the process of Terauchi to prepare the chocolate drink of the claims. It is appreciated that homogenization is not mentioned but to homogenize the cacao mixture of

Terauchi would have been an obvious way to mix the cocoa drinks that were prepared for taste evaluation. It is appreciated that the fat content of the beverage is not mentioned but to optimize the cacao butter content of Terauchi would have been an obvious way to control the caloric content of the beverage. It is appreciated that the packaging container is not mentioned but packaging foods in transparent containers is well known in the art.

Applicant argues that Terauchi does not use two phase separation but rather uses a three stage separation. This has been considered but is not persuasive. Terauchi uses a centrifuge that is described as a continuous solid/liquid separator that is maintained at 90C. The cocoa butter would be expected to be extracted as liquid in the centrifuge at 90C. Applicant argues that Terauchi does not use cocoa nibs. This is disagreed with. In example 2 cacao nibs are treated (column 6, line 55 of '444). In examples 1 -3 of '562 cacao nibs are treated.

Claims 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

There is no antecedent basis in claim 1 for the homogenization step described in claims 7 and 10. An amendment to claims 7, 8 and 10 changing the claim to depend from claim 5 would overcome the rejection.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached by dialing 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Carolyn Paden/

Primary Examiner 1794